

Application No.: 10/675,906

Docket No.: HO-P01715US2

c.) Remarks

As of this response, only claims 24-38 remain in the application. Claims 1-24 were previously cancelled, and are therefore withdrawn from consideration as noted in the Office Action.

Claims 25-38 were rejected "as having no error correctable by reissue." It is submitted that this reason for rejecting the claims is clearly in error and should be withdrawn for the reasons stated below. Therefore, reconsideration of the rejection is respectfully requested.

The basis given for this rejection is that claims 25-38 are independent or distinct from the invention in claims 1-24, that are in U.S. patent 6,148,925, which is the patent for which reissue was requested. It was explained in the Office Action that since claims 25-38 are "to subject matter drawn to an invention that is patentably distinct from the invention claimed in the patent, 37 C.F.R. 1.176 now permits the Examiner to make a requirement for restriction, but a restriction requirement cannot be provided since added claims 25-38 are constructively non-elected and withdrawn from consideration and original patent claims have been canceled in the present application."

This rejection ignores the fact that this application is a divisional of the parent reissue application S.N. 10/299,547, filed on November 19, 2002. In that application, claims 1-24 were asked to be reissued in the initial application. Claims 25-38 were added by preliminary amendment filed on the same day. In the first Office Action in the parent application, mailed February 14, 2003, on p. 2 (copy attached), claims 1-24 were examined, and claims 25-33 were "withdrawn from consideration as being directed to a non-elected invention" based on the Examiner's characterization as these claims having been "constructively elected" because an action on the merits of claims 1-24 was received. The Examiner cited 37 C.F.R. §1.176 (b), which allows the Examiner to issue a restriction between subject matter of the original patent claims and previously unclaimed subject in a reissue application, and if restriction is required then the subject matter of the original patent claims will be constructively elected unless a disclaimer is filed.

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Then, applicant filed this divisional application, on September 30, 2003. A preliminary amendment was filed along with the application in which claims 1-24 were cancelled and the same claims 25-33 (that were constructively elected in the parent application) were added. (Additional dependent claims 34-38 were added later in an amendment filed on March 4, 2005.)

Thus, claims 25-38 were filed in this divisional application are elected claims because they were non-elected claims in the parent application. For this reason, applicant respectfully requests that the rejection be withdrawn.

Alternatively, even if claims 25-38 are not considered to be "elected claims" in this divisional application, the rejection is contrary to the provisions of 35 U.S.C. § 251 and 37 C.F.R. §1.177 (b).

Under 35 U.S.C. § 251, a patent is entitled to be reissued if it is deemed to be wholly or partly inoperative or invalid by reason of a patentee claiming less than he had a right to claim. That standard has been satisfied here, and support has been shown in the patent for all of the elements of claims 25-38.

37 C.F.R. §1.177 (b), provides that if more than one application for reissue of a patent is filed, the same claim of the patent being reissued may not be presented in its original unamended form on more than one application. This requirement prohibits the situation contemplated in the Office Action in this application, where original claims 1-24 would have to be presented for examination in their unamended form, so that a restriction can be issued before claims 25-38 could be considered to be elected and then examined.

Here, claims 1-24 are the original claims in the patent sought to be reissued. They are pending in the parent application, S.N. 10/299,547, filed on November 19, 2002. These claims stand allowed and will not issue until the issues in this application are resolved under 37 C.F.R. §1.177 (b). The fact that these claims are present in the parent case precludes them from being submitted in this application. Thus, the preliminary amendment canceling the original claims was proper. To do otherwise, and invite a restriction requirement, would have been a violation

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of 37 C.F.R. §1.177 (b). Thus, the basis for the rejection is clearly erroneous and it should be withdrawn.

Applicant believes that no additional fee is due with this response. However, if a fee is due, please charge Deposit Account No. 06-2375, under Order No. HO-P01715US, from which the undersigned is authorized to withdraw.

In light of the arguments and amendments made herein, Applicants respectfully assert that the pending claims are in condition for allowance. Because the Examiner's rejections have been addressed, Applicants respectfully request withdrawal of the outstanding rejections. Accordingly, Applicants earnestly request allowance of the pending claims. This is intended to be a complete response. If any issues remain outstanding, please contact the undersigned for resolution of the same.

Applicant believes no fee is due with this response; other than the Three-Month Petition for Extension of Time in which to file this Response. However, if a fee is due, please charge our Deposit Account No. 06-2375, under Order No. HO-P01715US2 from which the undersigned is authorized to draw.

Dated: July 25, 2006

Respectfully submitted,

By

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/299,915	11/19/2002	Boyd B. Moore	HO-P01715US0	5243

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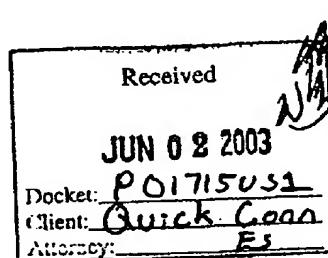
EXAMINER

SUCHFIELD, GEORGE A

ART UNIT	PAPER NUMBER
3672	

DATE MAILED: 05/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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JUL 25 2006

Office Action Summary	Application No.	Applicant(s)
	10/299,915	
Examiner	Art Unit	3672
	George Suchfield	

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address.
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.138(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 14 February 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

4) Claim(s) 1-33 is/are pending in the application.

4a) Of the above claim(s) 25-33 is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-24 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) 1-33 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 19 November 2002 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1448) Paper No(s) 4.	6) <input type="checkbox"/> Other: _____

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1. The claims in this application do not commence on a separate sheet in accordance with 37 CFR 1.52(b). Appropriate correction is required in response to this action.
2. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.
3. Newly submitted claims 25-33 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The conductor wire line set forth in these claims could be assembled or manufactured by methods other than, or not requiring, the specific steps of the method of claims 1-24, i.e., not requiring the tubing to be positioned in a well or vertical passageway and a weight attached to the optical fibers. For example, the optical fibers of claim 25 may be inserted into a tubing, e.g., by using any conventional thrust or emplacement means, such as a tractor, and/or while both the optical fibers and tubing are in an above-ground horizontal position. Alternatively, the optical fibers and/or conductor wire(s) could be emplaced within the tubing during the manufacture of the tubing itself, e.g., by emplacement on a flat, elongated steel material, which is then formed into a generally circular tubing surrounding the optical fibers and/or conductor wire(s).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 25-33 stand withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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4. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

5. Claims 1-24 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Aguesse et al (6,170,570), Head (6,112,813), Griffioen (6,047,954), Newman (6,247,534) and Kobylinski (6,179,269) disclose exemplary techniques of emplacing a conductor wire or optical fiber in a tubing; other references listed were cited as pertinent art in the prosecution of the patent file.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Suchfield whose telephone number is 703-308-2152. The examiner can normally be reached on M-F (6:30 - 3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 703-308-2151. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

George Suchfield
Primary Examiner
Art Unit 3672

gs
May 22, 2003